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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/863,644 | 05/23/2001 | Patricia McLaughlin | MCLAU-001 | 1039 |

7590 09/11/2007
MITCHELL A. STEIN
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EXAMINER

MENDIRATTA, VISHU K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3711

| MAIL DATE | DELIVERY MODE |
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09/11/2007

PAPER

#13

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/863,644

Applicant(s)

MCLAUGHLIN, PATRICIA

Examiner

Vishu K. Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The amendment filed 11/7/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: *"said base does not contain home positions". The original disclosure is silent with respect to home positions being on not being.*

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *"said base does not contain home positions". The original disclosure is silent with respect to home positions being on not being.*

Claim Rejections - 35 USC § 102

4. Claims 1-4 rejected under 35 U.S.C. 102(b) as being anticipated by Shoptaugh (3731934).

Claim 1: Shoptaugh teaches game pieces (15,17), at least four slats (19,21,23,25) each having at least four apertures (27,29). The newly added limitation does not further limit the claimed apparatus due to being a negative limitation. A claim is weighed for what it has and not for what it does not have.

Claim 2: playing pieces of different colors (1:40-42).

Claims 3-5: Shoptaugh teaches number of slats and holes could vary to be any desired structure (2:51-55).

Claims 6-11: Shoptaugh teaches game pieces (15,17), at least four slats (19,21,23,25) each having at least four apertures (27,29), playing pieces of different colors (1:40-42). Shoptaugh teaches number of slats and holes could vary to be any desired structure (2:51-55). Shoptaugh teaches players selecting playing pieces (2:18-22), players placing selecting possible moves (2:24-38).

Claim Rejections - 35 USC § 103

5. Claims 3-5,6-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shoptaugh.

Claims 3-5: Shoptaugh teaches all limitations except that it does not expressly teach number of slats equal to number of apertures and that number being four (claim 3-4) and eight (claim 5).

Shoptaugh teaches number of slats and holes could vary to be any desired structure (2:51-55).

Whereas young players (children) like to play a much simpler game others (grownups) like to play a much more challenging game with more complicated structure. In order to make the game appropriate for players who like to play challenging games, it would have been obvious to provide a structure with higher number of slats and apertures. One of ordinary skill in art at the time the invention was made would have suggested creating game structure with higher numbers of slats and apertures.

Claims 6-11: Shoptaugh teaches all limitations except that it does not teach expressly teach one of the two possible moves. Shoptaugh indicates that the game can vary in specifics of the rules, in that a simpler game can allow both moves or a harder game can allow only one of two moves depending on the agreement by players.

One of ordinary skill in art at the time the invention was made would have suggested selecting one of two moves for making the game appropriated for grownup players.

Moving game pieces to the other end can be treated as a predetermined arrangement.

Claim 12: In order to make the game appropriate for players who like to play challenging games, it would have been obvious to use requirement of more complicated arrangement of end configurations. One of ordinary skill in art at the time the invention

was made would have suggested a diamond or any other shape to be achieved by players.

Claim 13: In order to make the game popular, it would have been obvious to use computer applications of the game.

One of ordinary skill in art at the time the invention was made would have suggested playing the game on computers.

Response to Arguments

6. Applicant's arguments filed 11/7/05 have been fully considered but they are not persuasive.

Applicant argues that Shoptaugh fails to describe the apparatus whereby a winner is determined.....". Arguments do not indicate to which apparatus limitation is not taught by Shoptaugh.

And Moving game pieces to the other end can be treated as a predetermined arrangement.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
March 16, 2007